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OFFICE OF PETITIONS

In re Application of	:	
Pekka Lonka	:	
Application No. 10/692,273	:	DECISION ON PETITIONS
Filed: October 23, 2003	:	PURSUANT TO
Attorney Docket Number: 297-	:	37 C.F.R. § 1.183 AND
008681-US (REI)	:	RENEWED PETITION PURSUANT
Title: MOBILE COMMUNICATIONS	:	TO 37 C.F.R. § 1.137(B)
DEVICE WITH A CAMERA	:	

This is a decision on the "petition under 37 C.F.R. § 1.183 and 1.47," filed on September 9, 2009. This submission is being treated as a petition pursuant to 37 C.F.R. § 1.183,¹ requesting the waiver of 37 C.F.R. § 1.63(a)(1).² This is also a decision on the concurrently filed renewed petition pursuant to 37 C.F.R. § 1.137(b), to revive the above-identified application.

The renewed petition pursuant to 37 C.F.R. § 1.137(b) is **GRANTED**.

The petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED**.

The present application No. 10/692,273 is for the reissue of U.S. Patent number 6,308,084, which issued on October 23, 2001, from application number 09/325,025.

Both a notice of appeal and a "Pre-Appeal Brief Request for Review" were submitted on December 11, 2006. The above-identified application became abandoned for failure to reply in a timely manner to the "Notice of Panel Decision from Pre-Appeal

¹ See MPEP § 603: "[w]hen an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183."

² The non-final Office action indicated that the reissue declaration that was present on filing was defective.

Brief Review," mailed January 23, 2007, which set a one-month period for response. No response was received, and no extension of time under the provisions of 37 C.F.R. § 1.136(a) was requested. Accordingly, the above-identified application became abandoned on February 24, 2007. A notice of abandonment was mailed on January 7, 2008.

RELEVANT REGULATIONS AND PORTION OF THE MPEP

37 C.F.R. § 1.63(a)(1) sets forth, *in toto*:

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(1) Be executed, i.e., signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.175(a) sets forth, *in toto*:

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

PROCEDURAL HISTORY AND ANALYSES

The renewed petition pursuant to 37 C.F.R. § 1.137(b):

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition

pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;

- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

A petition, pursuant to 37 C.F.R. § 1.181, to withdraw the holding of abandonment was filed on January 15, 2008, and was dismissed via the mailing of a decision on July 14, 2008.

An original petition pursuant to 37 C.F.R. § 1.137(b) was filed on July 31, 2008, along with an amendment, the petition fee, and the proper statement of unintentional delay. The original petition pursuant to 37 C.F.R. § 1.137(b) was dismissed via the mailing of a decision on March 10, 2009, which stated that the second and third requirements of Rule 1.137(b) had been satisfied, the fourth requirement is not applicable, and the amendment was not deemed to place this application in condition for allowance (thus, the first requirement of Rule 1.137(b) had not been satisfied).

With this renewed petition pursuant to 37 C.F.R. § 1.137(b), Petitioner has submitted an amendment which has been considered by the Examiner and has been deemed to place this application in condition for allowance. It follows that the first three requirements of Rule 1.137(b) have now been satisfied and the fourth requirement is not applicable.

The petition pursuant to 37 C.F.R. § 1.183:

It is noted that both a statement pursuant to 37 C.F.R. § 3.73(b) and the written consent of the assignee were concurrently filed on January 23, 2004.

This petition cannot be granted, as Petitioner has not asserted, much less established, the existence of an extraordinary situation such that justice requires the waiver of the requirement that the supplemental reissue declaration be executed by the sole inventor.

On renewed petition, Petitioner will need to assert the existence of an extraordinary situation, such that justice requires the waiver of the requirement that the sole inventor must execute the supplemental reissue declaration.

Assuming arguendo that Petitioner has asserted the existence of an extraordinary situation such that justice requires the waiver of the requirement that the supplemental reissue declaration be executed by the sole inventor, this petition cannot be granted as the record does not support a finding that this assertion has been established. A discussion follows.

While Rule 1.47(b) is not directly applicable to the current set of facts, it does provide a similar method for rectifying situations involving the refusal of an inventor to execute a declaration. As such, a Rule 1.47(b) analysis will be applied to determine whether an extraordinary situation is present, such that justice requires the waiver of Rule 1.63(a)(1). The applicable elements are as follows:

- (1) a statement of the last known address of the sole inventor;
- (2) proof that either:
 - (a) a copy of the application was sent or given to the sole inventor for review and proof that he/she has refused to sign, or;
 - (b) proof that diligent efforts have been made to locate the sole inventor;
- (3) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (4) proof of irreparable damage, and;
- (5) an acceptable oath or declaration in compliance with 35 U.S.C. §§. 115 and 116 and 37 C.F.R. § 1.63.

With this petition pursuant to 37 C.F.R. § 1.183, Petitioner has included a portion of the petition fee,³ the last known address of the non-signing sole inventor,⁴ proof that a complete copy of the application was sent to the last known address of the non-signing sole inventor,⁵ and proof that he has refused to execute the supplemental reissue declaration.⁶

Requirements (1) - (3) above have been satisfied.

³ \$200 has been submitted. The additional \$200 will be charged to Deposit Account No. 16-1350 in due course, as authorized on the second page of this petition.

⁴ Statement of facts, section II.

⁵ *Id.* at III(5-10)

⁶ *Id.* at III(8 and 10).

Regarding the fourth requirement, no proof of irreparable damage has been submitted.⁷ A statement by Rule 47(b) applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Regarding the fifth requirement, a supplemental reissue declaration has not been located in the electronic file. On renewed petition, Petitioner must include a supplemental reissue declaration that has been executed in accordance with MPEP §§ 324 and 409.03(b).

CONCLUSION

The time period for filing a renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.183." This is not a final agency action within the meaning of 5 U.S.C § 704. '

Any such renewed petition should indicate in a prominent manner that the attorney handling this matter is Senior Attorney Paul Shanowski, and may be submitted by mail,⁸ hand-delivery,⁹ or facsimile transmission (FAX).¹⁰ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.¹¹

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanowski at (571) 272-3225.¹² All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

⁷ See MPEP § 409.03(g).

⁸ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁹ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

¹⁰ (571) 273-8300 - please note that this is a central facsimile number.

¹¹ <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

¹² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).